



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Junya SHIRAHATA

Group Art Unit: 1793

Application No.: 10/787,194

Examiner: C. NGUYEN

Filed: February 27, 2004

Docket No.: 118831

For: EXHAUST-GAS PURIFYING CATALYST

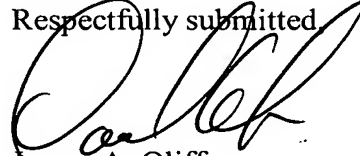
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This request is being filed with a Notice of Appeal and Petition for Second One-Month Extension of Time. Review of the May 6, 2008 Final Rejection is requested for the reasons set forth in the attached five or fewer sheets.

Should any questions arise regarding this submission, or the Review Panel believe that anything further would be desirable in order to place this application in even better condition for allowance, the Review Panel is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

Daniel A. Tanner, III
Registration No. 54,734

JAO:DAT/lmf

Date: May 12, 2008

REMARKS

Claims 1-4 are pending in this application. In reply to the December 11, 2007 Office Action, Applicant filed a Request for Reconsideration After Final Rejection ("Request") on April 10, 2008. The Request argued why Applicant believes that the prior art rejection of the pending Office Action is in error. In reply, an Advisory Action was mailed on May 6, 2008 which states, in pertinent part, that for the same reasons set forth in the Final Office Action, the Request for Reconsideration is not considered to place the application in condition for allowance.

Applicant believes that upon review of the December 11 Office Action, in light of the following remarks, supplementing those forwarded with Applicant's April 10 Request, the Review Panel will determine that the current rejections of record should be withdrawn.

The Office Action, in paragraph 3, continues to reject claims 1-4 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0028589 to Reisinger et al. (hereinafter "Reisinger"). This rejection is respectfully traversed.

In response to the arguments made in Applicant's April 10 Request, the Advisory Action continues to erroneously conclude that any catalyst disclosed in Reisinger is the same as Applicant's claimed catalyst. Applicant is aware that it is the catalytic structure and characteristics of the catalyst that determine the patentability of the claimed catalyst and not its intended use limitations, as instructed by the Advisory Action. In this regard, Reisinger does not clearly teach the claimed catalyst having the claimed structure of the same catalytic materials, as is recited in the pending claims, as is incorrectly asserted by the Advisory Action. Applicant's arguments in the April 10 Request, which are set forth in relevant detail below, specifically argue the differences in catalytic structure and characteristics of the catalyst and not merely an intended use, as is asserted by the Advisory Action.

Reisinger teaches a high performance catalyst containing a layer of an inert carrier body comprising noble metals such as platinum group deposited on support materials ("Abstract"). Specifically, Reisinger teaches that a loading layer (the layer on the inert carrier body) contains platinum deposited on support materials comprising metal oxides selected from the group consisting of zirconia, zirconia-rich ceria/zirconium mixed oxide, and others. Reisinger further teaches that the support materials may contain zirconia or ceria-rich ceria/zirconium mixed oxide.

In this regard, Reisinger merely indicates that the noble metal is loaded on support materials containing metal oxides. Reisinger does not indicate a ratio of the metal oxide in the loading layers specifically. With reference to Table 1, Reisinger shows an example in which alumina is contained in the amount of 50% by weight in the loading layer, i.e., alumina is a main component of the loading layer. With reference to, for example, paragraphs [0018] and [0019] of Reisinger, the Office Action alleges that Reisinger can reasonably be considered to teach a combination of all of the features positively recited in independent claim 1. Applicant has previously argued on several occasions that the analysis of the Office Action, now as repeated in the Advisory Action, necessarily fails for several reasons. In fact, the Office Action specifically states that "[w]hile there might be no examples exemplifying the claimed metal ratios, however, in view of the teaching of the platinum amount (which is from 0.01 to 5 wt.%) and the stabilizer amount (which is 0.5 to 20 wt.% of lanthana) contained in the coating layer, which provides for the amount of metal oxide being more than 80% by weight." In this regard, the Office Action concludes that the metal oxide ratio does not appear to be patentably distinguished from the disclosed metal oxide ratio. The Office Action, however, fails to make a positive showing regarding how each of the positively recited claim features of, for example, claim 1 is explicitly or impliedly taught by the Reisinger reference.

Reisinger shows only the catalyst having a loading layer whose main component is alumina. The subject matter of the pending claims is directed to ceria-zirconia or the composite compound being contained in an amount of 80% by weight or more in the loading layer. It has not been adequately shown in the reference that such a feature is explicitly disclosed. In fact, the Office Action indicates that such a feature is not explicitly disclosed. Rather, the Office Action apparently attempts to rely on some theory of inherency given some broad assertions regarding features disclosed in the Reisinger reference to arrive at the conclusion that the specific structure and characteristics of the claimed catalyst are taught by that reference. Reisinger does not teach a ceria-zirconia or composite compound, which is a main component of the loading layer of the subject of the pending claims, in the composition recited in the pending claims. The criticality of the recited composition is that it has an oxygen storage capability. Alumina, which is the main component of the alleged loading layer in Reisinger, does not have such an oxygen storing ability. In this regard, Applicant previously argued that not only are the subject matter of the pending claims and any alleged loading layer in Reisinger composed of quite different substances, but the criticality of the difference in these substances is directed to a specifically different objective.

Applicant is not relying on some limitation based on intended use. Rather, Applicant is specifically arguing that the characteristics of the catalyst which the Advisory Action admits determines the patentability of the claimed catalyst is different between the subject matter of the pending claims and anything that can reasonably be considered to have been suggested in the Reisinger reference. To any extent that the Office Action, and now the Advisory Action, rely on some theory regarding what, although not explicitly shown in the reference, is implied by the reference, this argument fails to meet the appropriate standard. It has not been adequately shown how the combinations of features, which the Office Action

admits are not shown by the reference, necessarily flow from any teaching of the reference, which is the required standard for the Office Action to rely on a theory of inherency.

Further, with respect to anticipation of ranges, which the Office Action, and now the Advisory Action, attempt to indicate may be somehow disclosed by the Reisinger reference, Applicant previously argued at page 4 of the April 10 Request that the allegedly anticipating ranges are not "disclosed in the reference with 'sufficient specificity to constitute anticipation under the statute.'" The response, outlined in detail, in the Advisory Action fails to even address Applicant's arguments. As such, even to the extent that the claimed range is somewhere within some possible, not explicit, inherent broad range of potential ranges allegedly disclosed by the Reisinger reference, it has been adequately shown that advantages of the narrow range as claimed are not predictable or other otherwise foreseen, therefore the narrow range, as claimed, is not anticipated. The ongoing failure of the Advisory Action, as did the previous Office Action, to address this argument makes the analysis of the Office Action and the Advisory Action incomplete.

In summary, despite the assertions to the contrary in the Office Action, Reisinger does not teach, explicitly or impliedly, the combination of all of the specific characteristics positively recited in, for example, independent claim 1, and adequate proof has not been shown to support a conclusion that the subject matter of the pending claims are anticipated by this reference.

In view of the foregoing, Applicant respectfully submits that this application is in condition for allowance. Favorable reconsideration by the Review Panel and allowance of claims 1-4 are earnestly solicited.